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EXAMINER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PHYLLIS A. ELLENDMAN

Appeal 2008-0567
Application 09/916,971
Technology Center 2100

Decided: September 26, 2008

Before HOWARD B. BLANKENSHIP, JAY P. LUCAS, and
THU A. DANG, *Administrative Patent Judges*.

BLANKENSHIP, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 1-14, which are all the claims in the application. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

Appellant's invention relates to one or more special fields that are used to specify addresses to be removed from address fields in preparation for sending an electronic mail message. (Abstract.) Claim 1 is illustrative.

1. A method by which an electronic mail system sends an electronic message comprising the following steps:

(a) in preparation for sending an e-mail message, performing the following by the electronic mail system:

 checking by the electronic mail system a field of the e-mail message used to specify addresses to be removed by the electronic mail system from a "To" field, and

 removing by the electronic mail system from any addresses specified in the "To" field of the e-mail message, any addresses within the field of the e-mail message used to specify addresses to be removed from the "To" field; and,

 (b) sending the e-mail message.

The Examiner relies on the following reference as evidence of unpatentability.

Meister US 6,671,718 B1 Dec. 30, 2003

Claims 1-14 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Meister.

Meister

Meister describes a system that modifies the operation of a conventional electronic mail system to alert the user before messages are sent. The system allows the user to change the e-mail recipients or cancel the message. Meister col. 2, ll. 49-59.

Meister's system alerts the user by popping up, or displaying, a dialog box 30 (Fig. 2), which provides a list of message recipients or their addresses. The dialog box 30 includes an "OK" control 44 that allows the user to approve or send the message to the listed recipients. The dialog box 30 also includes a "Modify Addressees" control 46 that allows the user to edit the list 33, removing any unintended recipients. An "erase" control 48 causes the message to be deleted. Meister col. 3, ll. 14-56.

In addition, as shown in Meister Figure 2, the dialog box 30 includes a confirmation box or field 50 corresponding to each entry on the list 33. The confirmation box is marked by the user to confirm that the particular recipient is intended. When the send control 44 is activated, the system can generate a new list without the unconfirmed names, with the dialog box 30 again appearing. Meister col. 3, l. 57 - col. 4, l. 3. Meister shows a typical Internet text e-mail message in Figure 3, comprised of header fields 62 and body 64. Col. 4, ll. 4-16.

Anticipation

Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim. *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1458 (Fed. Cir. 1984).

The law of anticipation does not require that a reference “teach” what an applicant’s disclosure teaches. Assuming that a reference is properly “prior art,” it is only necessary that the claims “read on” something disclosed in the reference, i.e., all limitations of the claim are found in the reference, or “fully met” by it. *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 772 (Fed. Cir. 1983).

The Rejection for Anticipation

Appellant argues that Meister does not disclose using a “field” of an e-mail message as required by instant claim 1. Appellant quotes the Examiner’s finding that the claimed “field” reads on the alias fields and address fields in the dialog box 30 depicted in Figure 2 of Meister. (Reply Br. 2.) Appellant ignores the finding and goes on to argue that the confirmation boxes 50 are not a field of an e-mail message and never appear within an e-mail message. (*Id.*, 2-4.)

Instant claim 1 does not require that the “field” of the e-mail message appear within the e-mail message. Claim 1 recites, in the final step, “sending the e-mail message.” However, Appellant’s method, even as described in the Specification, does not send the “field” of the e-mail message as part of the e-mail message. For example, a “Remove” field (Fig.

2) is used by the sender of the e-mail message to remove addresses before an e-mail message is sent. There is no description of the recipient of the e-mail message receiving the “Remove” field, within the e-mail message or otherwise. Rather, the field is for the sender to determine the addresses to which the e-mail message is to be sent. (*See* Spec. 2: 35-37; 4: 30-33; 6: 1 - 7: 32.)

We thus agree with the Examiner that the alias fields and address fields depicted in Figure 2 of Meister, and indeed the entire dialog box 30, meet all requirements of the “field” of the e-mail message recited in instant claim 1. Meister uses negative logic, not precluded by claim 1, to specify addresses to be removed by the electronic mail system from a “To” field. The *absence* of a mark in a particular confirmation box instructs the electronic mail system to remove addresses from the “To” field of the e-mail message (Meister Fig. 3) prior to sending.

Appellant places the other independent claims (8, 9, and 14) under separate headings in the Appeal Brief, but relies on the unpersuasive arguments about the claimed “field.” We are not persuaded of error in the rejection of any claim. We sustain the Examiner’s finding of anticipation with respect to claims 1 through 14. *See* 37 C.F.R. § 41.37(c)(1)(vii).

CONCLUSION

The rejection of claims 1-14 under 35 U.S.C. § 102(e) as being anticipated by Meister is affirmed.

Appeal 2008-0567
Application 09/916,971

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED

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